

REMARKS

Claims 30-49 are currently pending. Claims 30 and 40 have been amended for clarity. No new matter has been added.

By reopening prosecution only with respect to claims 38 and 48, Applicant assumes that the Examiner has adopted all of the remaining determinations of the Board. Of these remaining determinations, Applicant traverses the Board's affirmation of the rejection of claims 30-37, 39-47, and 49.

Claim Rejections - 35 USC 103***Claims 30-37, 39-47, and 49***

Although the Board of Patent Appeals and Interferences affirmed the Office's rejection of claims 30-37, 39-47, and 49, the Office has taken the extraordinary step of ignoring the Board's decision and re-opening prosecution. Applicant has therefore taken the opportunity to amend the independent claims 30 and 40 and submits that the Board's determination with respect to these claims no longer applies to the amended claims.

In affirming the rejection of claims 30-37, 39-47, and 49 as being obvious over U.S. Patent No. 4,882,675 to Nichtberger et al. in view of U.S. Patent No. 5,822,735 to DeLapa et al., the Board of Patent Appeals and Interferences relied upon the portion of the specification at page 6 that stated "[t]he term coupons, as used herein, shall mean any mode of communication with a consumer or a potential consumer offering a specific discount to the consumer wherein the consumer needs to bring such proof back to a store for redemption" to limit the term coupon to "coupons...capable of being brought into a store" such that the electronic coupons that

consumers can select in Nichtberger et al., were not considered to be coupons within the claims. Applicant submits that this is both an erroneous interpretation of the term coupon and an erroneous application of "coupon" to the claimed term "coupon information."

The statement on page 6 of the specification does not limit "coupons" to paper-type coupons. Indeed, the electronic coupons of both Nichtberger et al. and those of Applicant's invention require the consumer to bring proof of ownership (card 220 of Nichtberger et al. or a frequent shopper card of Applicant) back to the store for redemption. Furthermore, Applicant's specification, on page 8, clearly contemplates electronic coupons wherein it states "a store can mail to a consumer a periodic summary of the information on a regular basis and may include other promotions or *coupons that have already been entered into the system* based on the market information collected for that consumer." (Emphasis added) This use of electronic coupons that are outside the selection control of consumers has been specifically incorporated into presently amended claims 30 and 40, and is also found in claims 32 and 42.

Furthermore, the actual claim language "coupon information" is clearly different from "coupon" as defined by the Board. It is different in that coupon information can clearly be in electronic form; this is what is stored in the database, whether it is from a scanned paper coupon or from one "already entered into the system" by the store "based on the market information collected for that consumer." In Nichtberger et al., the selection of electronic coupons by the consumer adds coupon information to their accounts such that it falls outside the scope of the patent claims. Indeed, if "coupon" within the claims meant "paper coupon," then the adjective "paper" in the claim term "paper coupons" would be superfluous.

Applicant's invention both leverages the existing paper coupon system and eliminates the possible fraudulent use of electronic coupons by consumers (e.g., a consumer applying for multiple accounts in order to be able to select and use the same electronic coupons more times than permitted) by taking the selection of electronic coupons away from the consumer. In this way, electronic coupons can be used by manufacturers and stores to reward shoppers, yet be less prone to fraudulent schemes.

In view of the above-mentioned reasons, Applicant submits that claims 30-37, 39-47, and 49 are patentable over U.S. Patent No. 4,882,675 to Nichtberger et al. in view of U.S. Patent No. 5,822,735 to DeLapa et al. and respectfully requests reconsideration and allowance of the claims.

Claims 38 and 48

With respect to claims 38 and 48, which were previously rejected as obvious over Nichtberger et al. in view of DeLapa and further in vie of Official Notice, the Board of Patent Appeals and Interferences held that "the only suggestion for modifying Nichtberger in the manner proposed by the examiner to meet the limitations of claims 38 and 48 stems from hindsight knowledge derived from the Applicant's own disclosure." Although this holding specifically excluded consideration of Christensen (see fn. 9), it accepted the Official Notice that Internet review of coupons was known and agreed that the claim limitations were "not suggested by the Office Notice of reviewing coupons through the Internet."

The latest rejection from the Patent Office substitutes Christensen for the Official Notice of the prior rejection, with the stated motivation to combine being "because it provides convenience to the user by allowing the user to access coupons of interest quickly by performing

a word search, and review, select, and retrieve coupon information directly from the operations center." Applicant submits that Christensen is even less relevant than the prior Official Notice and that the Examiner has again impermissibly engaged in hindsight reconstruction based upon Applicant's disclosure.

U.S. Patent No. 6,035,280 to Christensen teaches a virtual coupon distribution system wherein users browse coupons using software on a personal computer and select coupons to be printed out for redemption via a coupon list. Although primarily disclosed as using a diskette for coupon distribution, Christensen further discloses that "diskette 310 may be substituted or augmented by downloading of data from an online service, Internet connection, E-mail, Website or the like." Nowhere does it teach or suggest Internet review of unutilized coupon information in a consumer's account. However, it does severely criticize the teachings of U.S. Patent No. 5,353,218 to DeLapa et al., which has an identical disclosure to the continuation application that led to issuance of the DeLapa et al. patent that forms a basis of the rejection (see Col. 2, ln. 36 to Col. 3, ln. 12 of Christensen)

Whereas Applicant's claimed invention, as a whole, seeks to turn traditional paper coupons into virtual coupons and eliminate the fraud associated with consumer-selection of electronic coupons, Christensen teaches the opposite, having consumers select virtual coupons for printing onto a paper list that is scanned for redemption to eliminate the fraudulent use of traditional paper coupons. The only purpose for (Internet) access to coupons on the computer in Christensen is to select coupons for printing on the list.

Additionally, Nichtberger et al. already teaches selection of coupons at home (col. 27, lines 46+) and seeks to eliminate paper coupons (i.e., teaches against printing out coupons for redemption) and therefore has no need to either seek or incorporate the teachings of Christensen.

Conclusion

For the above reasons, Applicant respectfully submits that the Office Action has failed to make out a *prima facie* case of obviousness with regard to claims 30-49, and requests reconsideration and allowance of the claims.

Respectfully submitted,



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